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/Lynne M. Milliot/  
Lynne M. Milliot

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Cowden et al.

Application No. 09/993,904

Confirmation No. 7663

Filed: 27 November 2001

Title: **METHOD AND APPARATUS FOR  
PROVIDING INFORMATION  
REGARDING COMPUTER  
PROGRAMS**

Group Art Unit: 2151

Examiner: Kamal B. Divecha

**CUSTOMER NO. 61081**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPEAL REPLY BRIEF**

Sir:

This Appeal Reply Brief is filed in support of Appellants' appeal from the Office Action mailed June 1, 2006, and in response to the Examiner's Answer mailed January 12, 2007. A request for oral argument accompanies this brief, and the fee required for such a request (\$1,000) is being electronically submitted herewith.

Should it be determined that any additional fees are required in connection with this communication, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 50-0869 (Attorney Docket No. CLAR 1054-1).

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## **I. AGREED POINTS**

The Examiner's Answer (hereafter "EA") acknowledges all of the preliminary sections required by the rules: Appellants' statement identifying the real party in interest, the lack of related appeals or interferences, the status of the claims, the status of amendments after final, the summary of invention and the issues on appeal. It also acknowledges the copy of appealed claims in the appendix.

In light of the agreement, the preliminary sections are not repeated in this reply.

## **II. REPLY TO EXAMINER'S ARGUMENTS**

### **A. Rejection of Claims 1, 2, and 4-7 under 35 U.S.C. 101**

The Examiner has withdrawn the rejection under Section 101.

### **B. Rejection of Claim 7 under 35 U.S.C. 101**

The Examiner has withdrawn the rejection under Section 101.

### **C. Rejection of Claims 1, 2, and 4-6 under 35 U.S.C. 112**

The Examiner has rejected Claims 1, 2, and 4-6 under 35 U.S.C. 112, second paragraph, on grounds that "the preamble teaches the process of providing product information to a user, whereas the body of the claim teaches the process of providing third-party information about the computer program to the user. In addition, the Examiner maintains that Claim 1 lacks an essential step, there being no correspondence between steps III and IV.

These rejections cannot bear their own weight. As to the former, the Examiner takes the position that "third-party information" in the body of the claim is not a species of "product information" recited in the preamble. While the Examiner helpfully recites suggested language, he never addresses exactly why "third-party" information is not acceptable. Based on either a plain-language understanding of the term, or the teaching of the specification, "third-party" relates to the source of the software, which concerns the product, which makes the information "product information." That portion of the rejection is not supported by either reason or fact.

**D. Rejection of Claims 1, 2, and 4-6 under 35 U.S.C. 103(a) as being unpatentable over Fawcett in view of Slotznick is Improper**

**1. Determining a first window**

Applicants argued that Fawcett does not respond to the limitation “determining if the first window includes an offer to download a computer program.”

The Examiner responded that because Fawcett teaches a system for updating existing software, it must determine whether a window offers to download software.

That argument misses the point of the process taught and claimed here. Fawcett deals with a system for upgrading and modifying software systems. As the Examiner admits, Fawcett includes a system for “automatically identifying software that may be appropriate for installation. (EA at 10). The present application does not do that; rather, the purpose of the present application is to check every window opened on the browser and to determine whether that window contains an offer to download software. Plainly, that task is different from detecting the need for software upgrades.

While the Examiner extols the advantages of the Fawcett teaching, he simply ignores the fact that it is not aimed at the problems addressed here, nor does it employ the same technique. He says, “[w]ithout ‘determining’ if the first window includes an offer ‘to download a computer program,’ the users in Fawcett will not be able to purchase the software.” (EA at 11). It is not clear what that statement means, because there is no indication that Fawcett ever employs a “first window,” given the automatic detection of a need for upgrade.

The Examiner’s argument here is pure speculation – no effort is made to show how a teaching about automatic software upgrades teaches how to detect and deal with pop-ups that try to download software. Indeed, the Examiner chastises Applicants for failing to adduce evidence proving that Fawcett did not render the invention obvious. That point, of course, completely reverses the burden of proof. The Examiner has not shown that Fawcett teaches the “determining” step.

**2. Identifying the computer**

Applicants had also argued that Fawcett did not teach “identifying the computer program” as required by Claim 1.

Here, the Examiner simply ignores basic claim construction. After describing how Fawcett detects and identifies software for upgrade, the Examiner states, “Also

note that the claim fails to teach or suggest the process of ‘identifying the computer programs listed in the offering window.’ The claim simply suggests identifying the computer programs.” EA at 15 (emphasis in original).

That statement is wrong.

As a matter of elementary claim construction, “the computer program” must have antecedent basis. That basis is found in the preceding line, which recites, “determining if the first window includes an offer to download a computer program.” Thus, **the only computer program available for identification is the one in the window**. Applicants do not suggest going afield, looking for computer programs to identify. Plainly set out in the claim is the sequence of detecting a window, determining if the window contains an offer to download software, and identifying the software. Fawcett does not teach or suggest such steps, as it is concerned with automatic determination of upgrade needs, not windows on the browser.

### 3. Displaying a second window

Applicants had also argued that Fawcett did not teach “displaying a second window” for communicating third-party information, as required by Claim 1.

Here, the Examiner engages in a complete flight of fancy. Because windows are broadly defined as devices to convey information, and third-party information is broadly defined (here, in any event) as useful information about the program, then of course, Fawcett must accomplish this about the upgrades it performs.

What the Examiner does not even try to do is to show that Fawcett opens **two** windows. Saying that Fawcett could open a second window if it so desired does not suffice to teach or suggest that one should detect a first window, determine its contents, and then, in certain circumstances, open a second window in response. Instead, the Examiner again chastises Applicants for their failure to prove that Fawcett does **not** open two windows.

The Examiner has not shown that the limitation is taught or suggested by Fawcett.

### 4. Third party information

Applicants had also argued that Fawcett did not teach displaying “third-party information” in the second window, as required by Claim 1.

The Examiner attempts to equate Fawcett's display of information about a new software version with the display recited in Claim 1. Unfortunately for that argument, the present application does not claim to have invented third-party information. Rather, the display of third-party information as claimed here results from the detection and identification of potentially harmful software offered via a pop-up window. The fact that the Fawcett system can inform a user about software upgrades does not teach or suggest this step.

### **5. Detecting a window**

Applicants had also argued that Fawcett did not teach displaying "detecting an occurrence of a first window in the computer," as required by Claim 1.

The Examiner must resort to pure hindsight to argue this point. Admitting that Fawcett cannot provide this step, he turns to Slotznick. Even then, however, there is no clear evidence of the step, and the only way to find this step is to call it "inherent in the filtering software known in the art." EA at 21. In short, **the Examiner can point to no example of the functionality recited in this step**. That falls short of the evidentiary standard required to reject claims.

Again, it should be emphasized that Applicants are not claiming the process of detecting a window. Rather, that step is part of a whole, and that whole is set out in Claim 1. Here, the Examiner cannot even adduce an example of the part, much less assemble a structure that teaches or suggests the claimed invention.

### **6. Motivation to combine**

Applicants pointed out the lack of any motivation to combine the teachings of Fawcett and Slotznick. The Examiner's response betrays the complete hindsight nature of the analysis here. If one steps back to look at the invention recited in Claim 1 **as a whole** and the teachings of Fawcett and Slotznick, the Examiner's reasoning process is revealed. Assuming for the moment that a person or ordinary skill in the art would look to Fawcett in the first place, and come up empty regarding a method for detecting an incoming harmful download, the Examiner would have that person look to a disclosure in which (by the Examiner's admission) the window recognition process is alleged to be "**inherent**" in a subsidiary method used by the system (the filtering system). The statement of that reasoning is sufficient, by itself, to refute it.

## **7. Claim as a whole**

As one works through the Examiner's consideration of each individual element of Claim 1, considering each element as it if were being claimed *per se*, one looks in vain for any treatment of the claim as a whole. Yet, Section 103 expressly requires that the prior art must show that **"the subject matter as a whole"** would have been obvious. That statutory requirement is ignored altogether.

The point of the Claim 1 is not to present a new method for opening a window, or detecting a window, or displaying information. The claimed invention seeks to prevent the unknowing downloading of potentially damaging software by detecting an offer for such software in a window and informing the user of that fact. Neither Fawcett nor Slotznick teaches or suggests that invention.

### **E. Rejection of Claim 7 under 35 U.S.C. 103(a) as being unpatentable over Fawcett in view of Slotznick**

Applicants devoted over two pages to the argument that Claim 7 is patentable over the combination of Fawcett and Slotznick. Casual inspection reveals that the arguments advanced there differ from those related to Claim 1, yet the Examiner chose not to respond to them. That argument is therefore admitted, and Claim 7 should be declared in condition for allowance.

### **III. CONCLUSION**

In view of the foregoing, Appellants ask that this honorable Board reverse the rejections of the claims. In addition, it is submitted that all claims which are the subject of this examination are now allowable, and a notice of intent to issue a patent is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication to our Deposit Account No. 50-0869 (Attorney Docket No. CLAR 1054-1).

Respectfully submitted,

Dated: March 15, 2007

\_\_\_\_\_/Joseph E. Root/  
Joseph E. Root  
Registration No. 30,678  
Attorney for Patent Owner

**HAYNES BEFFEL & WOLFELD LLP**

P.O. Box 366  
751 Kelly Street  
Half Moon Bay, CA 94019  
Telephone: (650) 712.0340  
Facsimile: (650).712.0263